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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,817	01/07/2002	Scott Russell	CRD-0988	2890

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EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/040,817

Applicant(s)

RUSSELL, SCOTT

Examiner

Victor X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 27 and 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5,6/02, 12/03
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims 17-26 and 28-33 drawn to non-elected invention. In 3/17/2004, applicant elected to prosecute Group I, Species I. Furthermore, it was stated that all claims in group I read upon the elected species. However, claims 17-26 and 28-33 do not read upon the elected species of Group I. Therefore, non-elected claims 17-26 and 28-33 are withdrawn from further consideration.

The requirement is deemed proper and is therefore made **Final**.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 11-16, 27 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniel et al (U.S. 6,001,118).

Daniel et al disclose in Figs. 14a-14c and col. 2, lines 10-42, a vascular filter system having the limitations of claims 1-3, including: a filter support structure (160); a plurality of struts (162, 164) extend there between. The struts further comprise proximal portion and distal portion. A porous filter membrane (168) connects to the filter distal portion and the plurality of struts. Deploying and releasing means, i.e., catheter (172) operatively associated with the filter

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support structure. Daniel et al disclose a device [that causes the filter to be positioned in the lumen of the vessel and causing the filter to achieve said larger second diameter]. Anti-migration means, i.e., Nickel-Titanium alloy associated with the filter support structure (see col. 8, lines 3-11 and col. 15, lines 9-15). Daniel et al disclose a device [that cause filter to remain stationary in the lumen of the vessel]. Retrieving means, i.e., the releasable and retrievable vascular system (170) associated with the filter support structure to allow capture of the filter and allowing removal of the filter (see col. 7, lines 53-57). The portion of the claim in brackets above indicates the intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Daniel et al reference which is capable of being used as claimed if one desires to do so.

As to claims 4-5, the device further comprises means to enhance the radiopacity of the device (see col. 14, lines 60-67); and wherein the porous filter membrane (168) is made of a polymeric material from a group consisting of polyurethane (see col. 11, lines 4-12).

As to claims 11-13 and 15-16, the deploying means comprises a catheter (120); the deploying means further comprising a shaft (14) having a proximal end and a distal end with the filter is capable of detachable or removable from the distal end of the shaft (see col. 7, lines 53-57). The catheter is made from a polymeric material. The shaft is made from a metallic or from a polymeric material (see col. 10, lines 8-11).

As to claim 14 and 27, the retrieving means comprises a guidewire (14) that is detachable or removable from the filter (see col. 7, lines 53-57).

As to claims 34-36, the device has anti-migration means, i.e., Nickel-Titanium alloy associated with the filter support structure (see col. 8, lines 3-11 and col. 15, lines 9-15). Daniel

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et al disclose a device [that cause filter to remain stationary in the lumen of the vessel].

Retrieving means, i.e., the releaseable and retrievable vascular system (170) associated with the filter support structure to allow capture of the filter and allowing removal of the filter (see col. 7, lines 53-57). The portion of the claim in brackets above indicates the intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Daniel et al reference which is capable of being used as claimed if one desires to do so.

Claims 1-3 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Bates et al (U.S. 6,179,859).

Bates et al disclose in Figs.1 and 3e , a vascular filter system having the limitations of claims 1-3, including: a filter support structure (30); a plurality of struts (32) extend there between. The struts further comprise proximal portion and distal portion. A porous filter membrane connects to the filter distal portion and the plurality of struts. Deploying and releasing means, i.e., catheter (21) operatively associated with the filter support structure. Bates et al disclose a device [that causes the filter to be positioned in the lumen of the vessel and causing the filter to achieve said larger second diameter]. Anti-migration means, i.e., Nickel-Titanium alloy associated with the filter support structure (see col.2, lines 25-46 and col.4, lines 20-37). Bates et al disclose a device [that cause filter to remain stationary in the lumen of the vessel]. Retrieving means, i.e., the releaseable and retrievable vascular system (fig. 1) associated with the filter support structure to allow capture of the filter and allowing removal of the filter. The portion of the claim in brackets above indicates the intended use and all other

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functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over Bates et al reference which is capable of being used as claimed if one desires to do so.

As to claim 7, wherein the deploying means comprises a storage tube (25) that has the filter (30) slidably insertable into the storage tube. The deploying means further comprising an obturator (11) that is slidably insertable into the storage tube. The obturator is positioned to push the filter (30) into the proximal end of the catheter.

As to claims 8-9, the storage tube and the catheter are made from a polymeric material (see col. 4, lines 5-10).

As to claim 10, the obturator is made from a polymeric material (see col. 3, lines 50-56).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Daniel et al (U.S. 6,001,118).

The system of Daniel could be made the pore size of the porous filter membrane is in the range of from about 20-300 microns. It has been held that changes in size only require routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to make the system for the porous filter membrane is in the range of from about 20-300 microns, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

*Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,944,728 to Bates

U.S. Pat. No. 6,500,182 to Foster

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen  
Examiner  
Art Unit 3731

Vn *VN*  
May 24, 2004

*Kevin T. Truong*  
KEVIN T. TRUONG  
PRIMARY EXAMINER

*5/26/04*